

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 31-48 are currently pending. Claim 48 has been added; and Claims 31, 36, 41, and 46 have been amended by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 31-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,151,643 to Cheng et al. (hereinafter “the ‘643 patent”) in view of U.S. Patent No. 6,694,354 to Elg (hereinafter “the ‘354 patent”).

Applicants wish to thank the Examiner for the interview granted Applicants’ representative on February 19, 2009, at which time a proposed amendment to the claims was discussed. At the conclusion of the interview, the Examiner agreed that the proposed amendment would overcome the outstanding rejection of the claims.

Amended Claim 31 is directed to a method of updating a first version of a device driver installed on a computer of a user, the method comprising: (1) transmitting, to an office device by the first version of the device driver installed on the computer, a request for version information of a newest version of the device driver that is stored in a memory of the office device, the first version of the device driver being programmed to transmit the request to the office device; (2) receiving, from the office device to which the computer is communicatively coupled, the version information of the newest version of the device driver that is stored in a memory of the office device, wherein both the first version and the newest version of the device driver are configured to control operations of the office device; (3) determining, based on the received version information, whether the first version of the device driver installed on the computer is different from the newest version of the device driver stored in said memory; (4) if the determining step determines that the first version is different from the newest

version, inquiring whether the user wants to update the device driver on the computer with the newest version of the device driver; and (5) if the inquiring step determines that the user wants to update the device driver, obtaining the newest version of the device driver from the office device. The changes to Claim 31 are supported by the originally filed specification and do not add new matter.¹

Applicants respectfully submit that the rejection of Claim 31 (and all associated dependent claims) is rendered moot by the present amendment to Claim 31.

Regarding the rejection of Claim 31 under 35 U.S.C. § 103(a), the Office Action asserts that the '643 patent discloses everything in Claim 31 with the exception that "the first version and the newest version of the device driver are configured to control operations of the office device,"² and relies on the '354 patent to remedy that deficiency.

The '643 patent is directed to a computer-implemented method of providing information for software residing on a client computer. As shown in Figure 1, the '643 patent discloses a service provider computer system 102 that is connected to various software vendor computer systems 103, as well as various client computers 101. The '643 patent discloses that the service provider computer does not store the software updates, but rather stores information about where the software updates can be obtained, for example, from the software vendor computer systems themselves. In particular, the '643 patent discloses a method of providing information for software residing on the client computer that includes the steps of maintaining a service provider computer on a network; maintaining, on the service provider computer, a database that contains references to network locations where information from software vendors can be obtained; maintaining, on the service provider computer, a downloadable application that is capable of performing a scan of the client

¹ See, e.g., Figures 15 and 16 and the discussion related thereto in the specification.

² See page 6 of the outstanding Office Action.

computer to identify one or more products residing on the client computer; establishing a link between the client computer and the service provider computer over the network; downloading the application to the client computer over the communication link; scanning the client computer with the application; as a result of the scan, generating a list of software residing on the client computer for which the service provider has information; and for at least one product on the list, downloading to the client computer at least a portion of the information for that product that is available to the service provider.

However, Applicants respectfully submit that the '643 patent fails to disclose the step of transmitting, to an office device by the first version of the device driver installed on the computer, a request for version information of a newest version of the device driver that is stored in a memory of the office device, the first version of the device driver being programmed to transmit the request to the office device. The '643 patent is silent regarding a device driver installed on a computer and transmitting a request to an office device for version information of a device driver stored on the office device, wherein the first version of the device driver is programmed to transmit the request to the office device, as recited in amended Claim 31.

In this regard, Applicants note that the Office Action asserts on page 3 of the outstanding Office Action, that because the client application 104 analyzes the client computer to determine the list of installed software products and determines whether there is an update available for each software product, that "the drivers are still essentially making the request via the client application, i.e. the drivers provide version information to the application and that information is relayed to the service provider."³ However, Applicants note that the '643 patent does not state that the driver provides version information to the client application 104. Rather, the '643 patent discloses that the client application 104

³ See page 3 of the outstanding Office Action.

determines a list of the installed software products and then checks with the service provider computer 102 to see if an update is available. Moreover, Applicants note that Claim 1 requires that the device driver actively transmit a request for version information to an office device, and that the device driver is programmed to transmit the request to the office device. In contrast, the '643 patent does not disclose the transmitting of any request for version information to any device. While the client application 104 analyzes the client computer and communicates with the service provider, there is no transmitting of a request for version information to any device. Further, the '643 patent is silent regarding a device driver transmitting such a request. While the client application 104 disclosed by the '643 patent may arguably somehow "check" the version of every software application loaded on to the computer, there is no communication whatsoever between the device driver and the client application 104, as suggested by the Office Action.

Further, Applicants note that the Office Action asserts that "without the device drivers installed on the client computer, there would not be requests to update that driver."⁴ However, as discussed above, the checking of the version information is done by the client application 104, and is unrelated to and does not require any operation by the device driver, as required by Claim 31. The Office Action's argument is essentially that, based on the mere existence of the device driver on the computer, there is a request for version information by the device driver. However, Applicants note that Claim 31 recites transmitting by a device driver that has been programmed to transmit the request, a request to an office device, wherein the device driver controls operations of the office device. However, as discussed above, the method disclosed by the '643 patent does not require the device driver to do anything, whereas amended Claim 1 positively recites a step performed by the device driver.

⁴ See page 3 of the Office Action.

The '354 patent is directed to a method for a host computer to access device information corresponding to a peripheral device that is to be used in cooperation with the host computer, including the peripheral device providing to the host computer a first portion of a pointer representative of a peripheral device-specific part of the pointer; the host computer automatically producing a second portion of the pointer that points to a location from which the device information can be automatically downloaded to the host computer; the host computer combining the first portion and the second portion of the pointers; and the host computer using the pointer to download automatically the device information. In particular, the '354 patent discloses that the device information can include a device driver associated with the peripheral or product information about the peripheral device.⁵ Further, the '354 patent discloses that the downloading step can include downloading the device information from the peripheral device. In particular, as shown in Figure 8, the '354 patent discloses that the device driver can be stored in the peripheral device.

However, Applicants respectfully submit that the '354 patent fails to disclose the step of transmitting, to an office device by the first version of the device driver installed on the computer, a request for version information and the newest version of the device driver that is stored in a memory of the office device, the first version of the device driver being programmed to transmit the request to the office device, as recited in amended Claim 31.

Rather, the purpose of the '354 system is for a host computer that does not have a device driver to be able to obtain a device driver. Accordingly, the '354 patent discloses that the peripheral device is able to direct the host computer to the appropriate device driver that is stored at an external location or on the peripheral device. However, in the '354 system, the host computer does not initially have an installed device driver and thus cannot have a device

⁵ See column 6, lines 52-55.

driver that requests from an office device, information of a newest version of the device driver.⁶

Thus, no matter how the teachings of the '643 and '354 patents are combined, the combination does not teach or suggest the step of transmitting, to an office device by the first version of the device driver installed on the computer, a request for a version information of a newest version of the device driver that is stored in a memory of the office device, the first version of the device driver being programmed to transmit the request to the office device, as recited in amended Claim 31. Accordingly, Applicants respectfully submit that the rejection of Claim 31 is rendered moot, and that amended Claim 31 (and all associated dependent claims) patentably defines over any proper combination of the '643 and '354 patents.

Independent Claims 36, 41, and 46 recite limitations analogous to the limitations recited in Claim 31. Moreover, Claims 36, 41, and 46 have been amended in a manner analogous to the amendment to Claim 31. Accordingly, for the reasons stated above, Applicants respectfully submit that the rejections of Claims 36, 41, and 46 (and all associated dependent claims) are rendered moot by the present amendment to the independent claims.

The present amendment also sets forth new dependent Claim 48 for examination on the merits. New Claim 48, which depends from Claim 31, clarifies that the method includes the step of receiving, by the office device, the newest version of the device driver from a service center. New Claim 48 is supported by the originally filed specification and does not add new matter.⁷

⁶ See '354 patent, column 2, line 56 to column 3, line 5, which states that "when the host computer 11 requires a device driver for a different peripheral device, for example, when the host first communicates with a recently connected peripheral device at 13, the peripheral device communicates to the host computer 11 a partial pointer (a portion of a pointer), for example a partial URL as shown in Figure 1."

⁷ See Figure 10 and the discussion related thereto in the specification.

Thus, it is respectfully submitted that independent Claims 31, 36, 41, and 46 (and all associated dependent claims) patentably define over any proper combination of the '643 and '354 patents.

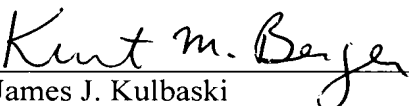
Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)


James J. Kulbaski
Registration No. 34,648
Attorney of Record

Kurt M. Berger, Ph.D.
Registration No. 51,461